The Examiner required additional information under 37 C.F.R. 1.105. After reasonable diligence and discussions with one named inventor, the following has been determined: the information required in items (i), (ii), and (vii) is unknown; no information is known to exist that satisfies the requirements in item (iii); no such information as required by items (iv) and (v) was used; and the information required in item (vi) is inapplicable. Claims 1, 5-7, 9, 11-17, 19 and 21-24 have been amended. Claims 8, 10, 18 and 20 have been cancelled. Claims 27-30 have been added. Figure 1 has been amended to correct a typographical error.

The Examiner rejected claims 1-20 under 35 U.S.C. § 101 because the claimed method does not recite a useful, concrete and tangible result. Specifically, the Examiner stated that the independently claimed invention is an abstract idea which can be performed without interaction of a physical structure. Independent claim 1 has been amended to include monitoring a watermark included with an advertisement. The watermark may be a faint signal that is embedded in the advertising content. The faint signal may be designed to be undetectable by users. See the present patent application, page 4, lines 21-25.

M.P.E.P. § 2106.IV.A states, "The plain and unambiguous meaning of § 101 is that any new and useful process, ... or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in title 35.... Thus, use of the expansive term 'any' in § 101 represents congresses intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101 and the other parts of title 35.... Thus, it is improper to read into § 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that congress clearly intended such limitations."

Independent claim 11 has been amended to recite a limitation similar to that discussed above with respect to independent claim 1, as amended.

The Examiner rejected claims 1-26 under 35 U.S.C. § 112, first paragraph, as being indefinite. Specifically, the Examiner stated that the specification discusses the claimed concept but does not enable one skilled in the art how the steps of monitoring and accruing including a processor-based device with a media player and watermark detector is enabled, based on the

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specification, such that one would know how to make and/or use the invention. MPEP § 2106.V.B.2 states, "The specification should disclose how to configure a computer to possess the requisite functionality or how to integrate the programmed computer with other elements of the invention, unless a skilled artisan would know how to do so without such disclosure." The Applicants contend that a skilled artisan would know how to use the invention by implementing the method using software, for example, without undue experimentation.

The Examiner further rejected claims 1-26 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Applicants have amended the claims accordingly.

Independent claim 1, as amended, calls for monitoring a watermark included with an advertisement and associating an indication that an advertisement was played with an identifier for a particular user.

Independent claim 1 stands rejected under 35 U.S.C. § 102(a) as being anticipated by the Applicants' specification. The Applicants request reconsideration and withdrawal of this rejection because the specification fails to teach or suggest monitoring a watermark included with an advertisement.

The specification states that, in many cases, it is desirable to insert commercials or advertisements into content as the content is selected. In one model, in return for a given number of advertisement viewings, the user may be entitled to play a certain amount of content. The specification makes no mention of monitoring a watermark included with an advertisement.

Independent claim 11, as amended, also distinguishes over the specification for reasons similar to those discussed above with respect to independent claim 1, as amended.

Independent claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Filepp, et al., U.S. Pat. No. 5,347,642 (hereinafter "Filepp"). The Applicants request reconsideration and withdrawal of this rejection because Filepp fails to teach or suggest monitoring a watermark included with an advertisement. Filepp describes an interactive computer system network that enables a user to display desired information and perform desired transactional services through any of a plurality of types of personal computers. User inputs are received by the personal computer and are translated into personal computer independent data objects and executable code objects which are then processed by the network. These objects

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comprise partitioned applications required to process user inputs, portions of which are distributed and stored. User characteristics are monitored by the system in order to generate and displace specific advertisements to the user based on individual usage characteristics and predetermined interests. Filepp makes no mention of monitoring a watermark included with an advertisement.

Independent claim 11, as amended, also distinguishes over Filepp for reasons similar to those discussed above with respect to independent claim 1, as amended.

Independent claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Hannah, U.S. Patent No. 5,550,595 (hereinafter "Hannah 1"). The Applicants request reconsideration and withdrawal of this rejection because Hannah 1 fails to teach or suggest monitoring a watermark included with an advertisement.

Hannah 1 describes a method and apparatus for processing video signals. A video camera may be interfaced with a video processor to supply video frames to the video processor. The video camera includes an automatic exposure setting mechanism for automatically updating at least one video exposure parameter before transmitting a next video frame to the video processor. The video camera enables or disables the automatic exposure setting mechanism in response to a strobe signal. The method and apparatus described by Hannah 1 has absolutely nothing to do with monitoring a watermark included with an advertisement.

Independent claim 11, as amended, also distinguishes over Hannah 1 for reasons similar to those discussed above with respect to independent claim 1, as amended.

Independent claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Hannah, U.S. Patent No. 5,568,192 (hereinafter "Hannah 2"). The Applicants request reconsideration and withdrawal of this rejection because Hannah 2 fails to teach or suggest monitoring a watermark included with an advertisement.

Hannah 2 describes a system and method for processing video signals. A plurality of video signals is captured with a camera in response to an image. The plurality of video signals is converted with the camera to a plurality of raw digital signals. A computer processes successive pluralities of raw digital signals at a predetermined frame rate. The bus has a communications bandwidth sufficient to transmit successive pluralities of raw digital signals in accordance with

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the predetermined frame rate. Hannah 2 has absolutely nothing to do with monitoring a watermark included with an advertisement.

Independent claim 11, as amended, also distinguishes over Hannah 2 for reasons similar to those discussed above with respect to independent claim 1, as amended.

Independent claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Fite, et al., U.S. Patent No. 5,557,721 (hereinafter "Fite"). The Applicants request reconsideration and withdrawal of this rejection because Fite fails to teach or suggest monitoring a watermark included with an advertisement.

Fite describes a method and apparatus for displaying advertisements and printing coupons on remote systems of a distributed data processing system. A host system downloads files describing the advertisements to be displayed and coupons to be printed to a remote system. The remote system keeps statistics on the number of times each advertisement is displayed and the number of times each coupon is printed, and periodically relays these statistics to the host system. Fite makes no mention of monitoring a watermark included with an advertisement.

Independent claim 11, as amended, also distinguishes over Fite for reasons similar to those discussed above with respect to independent claim 1, as amended.

Independent claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Graber, et al., U.S. Patent No. 5,717,860 (hereinafter "Graber"). The Applicant request reconsideration and withdrawal of this rejection because Graber fails to teach or suggest monitoring a watermark included with an advertisement.

Graber describes a method and apparatus for tracking the navigation path of a user that has been directed to a second site on the worldwide web ("WWW") from a first site on the WWW. A composite universal resource locator ("URL") symbol is received at the second WWW site when the user is directed from the first site to the second site. The composite URL symbol has a first portion corresponding to the URL symbol of the second site and a second portion that includes information corresponding to the identity of the first site. Information representative of the identity of the first WWW site is captured at the second WWW site from the second portion of the composite URL. The identity of the first WWW site has been determined at the second WWW site by comparing information from the second portion of the

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composite URL to a table having a plurality of entries, each of which is representative of a known WWW site. Graber makes no mention of monitoring a watermark included with an advertisement.

Independent claim 11, as amended, also distinguishes over Graber for reasons similar to those discussed above with respect to independent claim 1, as amended.

Independent claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Von Kohorn, U.S. Patent No. 5,916,024. The Applicants request reconsideration and withdrawal of this rejection because Von Kohorn fails to teach or suggest monitoring a watermark included with an advertisement.

Von Kohorn describes a system and method for evaluating responses to broadcast programs. The system includes an instructional signal modulated onto a signal transmitted concurrently with the television program or time multiplexed with television signals. Audience members may respond to a task or situation presented in the television program by entering a response. The system may include a video game machine suitable for playing commercially available games. Games may be interrupted for a sponsor's message, and an audience member's response to the message may serve as a basis for an enhanced score. In Von Kohorn, the instructional signal is merely modulated onto a signal transmitted concurrently with the television program or time multiplexed with television signals. Although an audience member's response to a task or situation may be used to determine a score for the audience member, the instructional signal itself is not monitored.

Independent claim 11, as amended, also distinguishes over Von Kohorn for reasons similar to those discussed above with respect to independent claim 1, as amended.

Independent claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Merriman, et al., U.S. Patent No. 5,948,061 (hereinafter "Merriman"). The Applicants request reconsideration and withdrawal of this rejection because Merriman fails to teach or suggest monitoring a watermark included with an advertisement.

Merriman describes methods and apparatuses for targeting the delivery of advertisements over a network, such as the Internet. Statistics are compiled on individual users and networks, and the use of the advertisements is tracked to permit targeting of the advertisements of

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individual users. In response to requests from affiliated sites, an advertising server transmits to people accessing the page of a site an appropriate one of the advertisements, based upon profiling of users and networks. Merriman makes no mention of monitoring a watermark included with an advertisement.

Independent claim 11, as amended, also distinguishes over Merriam for reasons similar to those discussed above with respect to independent claim 1, as amended.

Independent claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by d'Eon, et al., U.S. Patent No. 6,006,197 (hereinafter "d'Eon"). The Applicants request reconsideration and withdrawal of this rejection because d'Eon fails to teach or suggest monitoring a watermark included with an advertisement.

d'Eon describes a web advertising measurement system that correlates the number of impressions of web advertisements with post-impression transactional activity to measure the effectiveness of the advertisements. When a user clicks on a banner advertisement, an impression is established, and the user's identification is recorded. Then, when the user undertakes post-impression transactional activity, the transactional activity along with the user's identification is recorded. Based on the user identifications, the number of impressions associated with the advertisements are correlated to the post-impression transactional activity as a measure of effectiveness of each advertisement. According to d'Eon, consumers gain "impressions" of advertisements when they see the advertisements. See d'Eon, column 1, lines 18-19. d'Eon makes no mention of monitoring a watermark included with an advertisement.

Independent claim 11, as amended, also distinguishes over d'Eon for reasons similar to those discussed above with respect to independent claim 1, as amended.

Independent claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Goodman, et al., U.S. Patent No. 6,173,271 (hereinafter "Goodman"). The Applicants request reconsideration and withdrawal of this rejection because Goodman fails to teach or suggest monitoring a watermark included with an advertisement.

Goodman describes a television advertising automated billing system. Within the system, advertising is marked with a code at the time the advertising is produced. Then, when the advertising is broadcast, the code on the advertising is analyzed. Different security measures

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can be used, including producing the code in the closed captioning, so that many different people can see the code, or comparing codes in one part of the signal with a code in another part of the signal. The code is not equivalent to a watermark. A code is generally a symbol or the like that is to represent information and that is provided in lieu of the information itself. On the other hand, a watermark is a signal that is included with the advertisement. See page 4, lines 21-22 of the present patent application. Including a watermark may provide several advantages. In some embodiments, a watermark may be used to determine whether an advertisement is played as intended. For example, the watermark may be monitored to determine whether an advertisement is played in full at the predetermined play speed and is not otherwise muted, masked, fast-forwarded or stripped from the advertisement. See page 4, lines 9-15 of the present patent application.

Independent claim 11, as amended, also distinguishes over Goodman for reasons similar to those discussed above with respect to independent claim 1, as amended.

Independent claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Rhoads, U.S. Pat. No. 6,311,214 (hereinafter "Rhoads 1"). The Applicants request reconsideration and withdrawal of this rejection because Rhoads 1 fails to teach or suggest monitoring a watermark included with an advertisement.

Rhoads 1 describes linking computers based on optical sensing of digital data. A printed object is steganographically encoded with plural bit data. When such an object is presented to an optical sensor, the plural bit data is decoded and used to establish a link to an Internet address corresponding to that object. In Rhoads 1, a user may make a selection through the optical sensor input. For example, moving the object to the right can cause a user interface button on the right side of a dialog box to be selected. Moving the object to the left may cause a user interface button on the left side of the dialog box to be selected. Moving the object toward a camera may cause the selected button to be activated. See Rhoads 1, column 8, lines 50-56. However, Rhoads 1 makes no mention of monitoring a watermark included with an advertisement.

Independent claim 11, as amended, also distinguishes over Rhoads 1 for reasons similar to those discussed above with respect to independent claim 1, as amended.

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Independent claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Zhang, et al., U.S. Patent No. 6,325,420 (hereinafter "Zhang"). The Applicants request reconsideration and withdrawal of this rejection because Zhang fails to teach or suggest monitoring a watermark included with an advertisement.

Zhang describes a method for embedding non-intrusive encoded data in printed matter and a system for reading the same. The non-intrusive encoded data is referred to as a print control symbol. This symbol is located at a predetermined position on the printed matter, which is separated from the printed informational content. The print control symbol is hidden such that it is not apparent to a reviewer of the printed matter, and it encodes information concerning the printed matter. In Zhang, the print control signal is merely read by the printing system. No mention is made of monitoring a watermark included with an advertisement.

Independent claim 11, as amended, also distinguishes over Zhang for reasons similar to those discussed above with respect to independent claim 1, as amended.

Independent claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Rhoads, et al., U.S. Patent No. 6,442,285 (hereinafter "Rhoads 2"). The Applicants request reconsideration and withdrawal of this rejection because Rhoads 2 fails to teach or suggest associating an indication that an advertisement was played with an identifier for a particular user.

Rhoads 2 describes controlling operation of a device using a reconfigurable watermark detector. Reconfiguring the watermark detector may include changing how the watermark detector decodes or interprets a watermark embedded in a signal of a given media type. Rhoads 2 makes no mention of associating an indication that an advertisement was played with an identifier for a particular user.

Independent claim 11, as amended, also distinguishes over Rhoads 2 for reasons similar to those discussed above with respect to independent claim 1, as amended.

Independent claim 21, as amended, calls for a watermark detector to control operation of a media player in response to detection of a watermark.

Independent claim 21 stands rejected under 35 U.S.C. § 102(a) as being anticipated by the specification, under 35 U.S.C. § 102(b) as being anticipated by Filepp, Hannah 1, Hannah 2, Fite, Graber, Von Kohorn and Merriman, and under 35 U.S.C. § 102(e) as being anticipated by

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d'Eon, Goodman, Rhoads 1, Zhang and Rhoads 2. The Applicants request reconsideration and withdrawal of these rejections because all of these references fail to teach or suggest a watermark detector to control operation of a media player in response to detection of a watermark.

New claims 29 and 30 also distinguish over these references for reasons similar to those discussed above with respect to independent claim 21, as amended.

The Examiner rejected claims 1-26 under 35 U.S.C. § 103(a) as being obvious over the Examiner's personal experience. In compliance with M.P.E.P. § 2144.03, the Applicants request the Examiner to provide an affidavit or declaration setting forth specific factual statements and explanation to support the Examiner's finding. The Examiner noted that it is old and well-known to those skilled in the art of a method and system of medium storage instructions that it would have been obvious to claim the invention, as recited by the Applicants in order to overcome the explicit teachings of the Examiner's personal experience. The Applicants respectfully request that the Examiner provide a reference to support the Examiner's assertions.
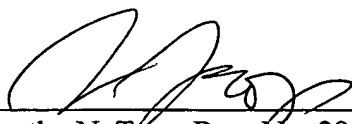
The Examiner provisionally rejected claims 1-26 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/896,772. The inventions of the present patent application and Patent Application No. 09/896,772 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions or different effects (M.P.E.P. § 806.04, M.P.E.P. § 808.01). The invention of the present patent application is directed to ensuring that advertisements are played. For instance, a system may confirm that advertising was played as originally intended. The invention of Patent Application No. 09/896,772 is directed to determining wireless device locations. For instance, wireless network devices can obtain their geographical location by triangulating with access points that have precise time information. Neither patent application discloses that these two inventions are capable of use together. Moreover, the two inventions have different effects.

In view of these remarks, the application is now in condition for allowance and the Examiner's prompt action is accordance therewith is respectfully requested.

Respectfully submitted,

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